

REMARKS

Claims 5 to 14 are now pending.

Reconsideration is respectfully requested based on the following.

With respect to page 2, paragraph 4 of the Final Office Action, claim 1 was rejected under the first paragraph of 35 U.S.C. § 112, as to the enablement requirement.

In particular, the Final Office Action conclusorily asserted the lack of enablement as to the feature of “the calculated time is calculated as a function of a collision velocity”, as provided for in the context of claim 1. It is respectfully submitted that support for the feature may be found, e.g., in the text from page 1, line 27 to page 2, line 17 of the Specification (in particular, page 2, lines 8 to 9). The specification explicitly discloses the feature of “determin[ing] the duration until the noise threshold is exceeded as a function of the velocity”, and that the “collision velocity is used for this purpose.” It is therefore respectfully requested that the enablement rejection be withdrawn for these reasons alone.

With respect to page 2, paragraph 5 of the Final Office Action, claims 11 to 14 were rejected under the first paragraph of 35 U.S.C. § 112, as to the enablement requirement.

In particular, the Final Office Action conclusorily asserted the lack of enablement as to the features of “an offset” and “the offset being inversely proportional to the collision velocity”, as provided for in the context of claims 11 to 14. Support for these features may be found, e.g., in Fig. 4 and in text from page 4, line 25 to page 5, line 8 of the Specification. Figure 4 discloses an adaptive determination of time between contact and the exceeding of the noise threshold. As in Fig. 4, the triggering functions change in terms of their position as well as their slopes, and the offset is inversely proportional to the collision velocity. It is therefore respectfully requested that the enablement rejections be withdrawn for these reasons alone.

Also in this regard, it is respectfully submitted that the Final Office Action's assertions and arguments presented simply do not reflect the standard for determining whether a patent application complies with the enablement requirement that the specification describe how to make and use the invention — which is defined by the claims. (See M.P.E.P. § 2164). The Supreme Court established the appropriate standard as whether any experimentation for practicing the invention was undue or unreasonable. (See M.P.E.P. § 2164.01 (citing Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916); In re Wands, 858

F.2d. 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988))). Thus, the enablement test is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” (See id. (citing United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement, and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See id. (citing In re Wands, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the Office’s analysis must therefore “consider all the evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” (See M.P.E.P. § 2164.01).

Also, the Office bears the initial burden of establishing why the “scope of protection provided by a claim is not adequately enabled by the disclosure.” (See id. (citing In re Wright, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993))). Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. (See id.).

In contrast to the above, however, the Final Office Action’s unsupported assertions simply do not concern — as they must under the law — whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation — which it plainly does, as evidenced, for example, by the above reference to the present application. In short, the Final Office Action’s assertions are merely conclusory and do not address the issue of whether one having ordinary skill would have to unduly experiment to practice the claimed subject matter of the rejected claims — a proposition for which the Office bears the burden of proving a prima facie case as to the rejected claims.

In this regard, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of Ex Parte Reese, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner's subjective belief that the specification was not enabling as to the claims. In particular, the examiner's subjective belief was simply not supported by any "evidence or sound scientific reasoning" and therefore ignored recent case law — which makes plain that an examiner (and not an applicant) bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in Ex parte Reese was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation — which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. (See id.). Moreover, the Board made clear that it is "incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence," and also made clear that "[where an] examiner's 'Response to Argument' is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph." (See id. at 1222 & 1223; italics in original). In the present case, the Office Action has not even alleged in a conclusory way that undue experimentation would be required. Moreover, even as to the assertions as presented, the present application plainly discloses how to use the subject matter of the rejected claims, as discussed above.

In view of all of the foregoing, it is plain that the Final Office Action's assertions to support the rejection of the claim simply do not satisfy the judicial standards discussed above with respect to the enablement requirement since the arguments and assertions presented do not relate the scope of the claim to the specification to determine whether the specification is enabling, nor do they properly address the enablement factors. It is therefore respectfully submitted that the Final Office Action has not even established a prima facie case as to the enablement requirement.

It is therefore respectfully requested that the enablement rejection be withdrawn based on the foregoing.

With respect to page 3, paragraph 3, claims 5 to 10 were rejected under 35 U.S.C. § 102(b) as anticipated by Takaya et al., U.S. Patent Number 5,497,327 (the “Takaya” reference).

To reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejection, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

Claim 5, as presented, is to a method for triggering a restraint device which includes the features of triggering the restraint device as a function of a collision signal and initiating the triggering when the collision signal exceeds a noise threshold *at a triggering time* in which *calculated time* required for the collision signal to exceed the noise threshold is taken into account in determining the triggering time for the restraint device, *in which the calculated time is calculated as a function of a collision velocity*.

As regards claim 5, the Final Office Action conclusorily asserts that the abstract, the text at column 3, lines 7 to 41 and column 5, line 4 to column 6, line 3, and Figures 1, 6 and 7 of the “Takaya” reference discloses the features as provided for in the context of claim 5. In particular, as regards the claim feature in which “*the calculated time is calculated as a*

function of a collision velocity”, and as explained in the prior response, the deceleration signal (g) is NOT “proportional to a vehicle collision velocity,” as conclusorily asserted. As commonly understood by a person in the art and clearly defined in dictionaries or textbooks, deceleration (or acceleration) is “the rate of change of velocity with respect to time” or broadly “change of velocity,” (see Merriam-Webster’s Collegiate Dictionary, Eleventh Edition). Deceleration is well understood as relating to the change of velocity, and *not to the value of the velocity*. Moreover, the text at page 3, par. 1-2, of the Specification makes it clear that velocity is the *integrated* acceleration signal (that is, the acceleration signal is the change of velocity -- as commonly understood by a person skilled in the art (or by almost any person for that matter)).

Therefore, there is simply no support for the assertion that “[a]cceleration or deceleration is proportional to a vehicle velocity.” In short, a deceleration signal (g) does not identically disclose the feature of “a collision velocity” as provided for in the context of claim 5.

Any reading of the “Takaya” reference makes plain that it does not concern velocity - let alone a collision velocity, for calculating its operating time (FT). Indeed, the “Takaya” reference does not even refer to the word “velocity.” Within the cited portion of the “Takaya” reference, the time (duration) is timed during a deceleration process until an integrated value exceeds a threshold value (see “Takaya” Abstract, Figure 7). This is wholly different than the calculated time required for the collision signal to exceed a noise threshold, in which the calculated time is calculated based on a function of a collision velocity, as provided for in the context of the claimed subject matter.

As regards the “triggering time” feature of claim 5, the operating timing (FT) in the cited reference does not identically disclose (or even suggest) the triggering time (accounted for a calculated time required for a collision signal to exceed a noise threshold), which is a time point at which the collision signal is checked to determine if the collision signal indeed exceeds the noise threshold, at which point the collision signal may exceed the noise threshold. When the collision signal exceeds the noise threshold at the triggering time, the triggering of a restraint device is initiated.

In stark contrast, the operating time (FT) in the cited reference relates to an operation time calculated until an integrated value (S) exceeds a threshold value (S_0) (see “Takaya,” Figures 7 and 8, Abstract; and column 5, line 51 to column 6, line 11). This does not identically disclose (or even suggest) the feature of a triggering time at which the collision

signal is checked against the noise threshold. Indeed, the operating time (FT) is determined only after the integrated value exceeds a threshold value, which is wholly different than the triggering time at which the collision signal is checked to determine whether it exceeds the noise threshold.

Accordingly, claim 5, as presented, is allowable, as are its dependent claims 6 to 10. Withdrawal of the anticipation rejections is therefore respectfully requested.

With respect to page 5, paragraph one (1), claims 11 to 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over the “Takaya” reference alone.

As regards the obviousness rejection, to reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 11 to 14 depend from claim 5, as presented, and are therefore allowable for essentially the same reasons as claim 5, as presented.

Still further, M.P.E.P. 2143.01 IV makes it clear that merely stating that the claimed subject matter is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. The Final Office Action does not present a *prima facie* case of obviousness because there is no proper support for the obviousness rejections.

Each of claims 11 to 14 includes the feature in which “the calculated time is an offset of the triggering time, the offset being inversely proportional to the collision velocity.” The Final Office Action did not specify any part of the “Takaya” reference that corresponds to the above highlighted feature. Instead, the Final Office Action only conclusorily asserted that claims 11 to 14 are obvious since the text in abstract and at col. 6, lines 12 to 19 of the “Takaya” reference is concerned with “implementing an offset constant decided by experiment.” This conclusory assertion simply does not satisfy the initial burden of the Office in presenting a *prima facie* case of obviousness as required by the M.P.E.P. and as clearly indicated by the *KSR* Supreme Court.

Therefore, withdrawal of the rejections of claims 11 to 14 is respectfully requested.

In sum, all of pending claims 5 to 14 are allowable.

CONCLUSION

In view of the foregoing, claims 5 to 14 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

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Respectfully submitted,

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